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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,151	03/06/2000	Manuel Zahariev	P3001D1	7821

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EXAMINER

DONAGHUE, LARRY D

ART UNIT PAPER NUMBER

2154

DATE MAILED: 06/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/519,151

Applicant(s)

Examiner

Group Art Unit

2154

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disp sition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Acti n Summary

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1. Claims 1-18 are presented for examination.
2. The disclosure is objected to because of the following informalities: The claim or claims must commence on separate sheet (37 CFR 1.52(b)). See 37 CFR 1.75 and MPEP § 608.01(m).

Appropriate correction is required.

3. Claims 13-18 are objected the term, machine-intelligent agent lacks antecedent basis in the specification.
4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,035,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because applicant has merely combined and /or deleted some of the elements of the claims of patent 6,035,105.

For example claim 6, of the instant application.

Requires an e-mail server with a system for receiving and forwarding e-mail and a Mail Alert system .

Claim 6, of Patent 6,035,104 sets forth at least an e-mail server (line 1) a system for receiving and forwarding e-mail (lines 2-3) and a Mail Alert system (lines 4-14). Applicant has merely combined the function of the elements of claim 6, and/or renamed them.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35

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U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1, 2, 5-6, 9-10, 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Pepe et al. (5,742,905).

Pepe et al. taught the invention (claim 1) as claimed, including a server (43) and a Mail Alert code , wherein the mail alert code is adapted to compare characteristics of the E-mail messages to specific characteristics prestored by the subscriber (col. 4, line 56- col. 5, line 9, col. 7, line 3-15) to alert the subscriber for forwarding the message (col. 34, lines 60-65; col. 4, lines 56-67).

Claims 5,9 and 13 fail to teach or define above or beyond claim 1, and are rejected for the reasons set forth above.

As to claims 2, 6, 10 and 15, Pepe et al. taught that the alert was sent to a pager (col. 5, lines 60-67).

As to claim 14, Pepe et al. taught an alert mechanism (col. 34, lines 60-65; col. 4, lines 56-67).

As to claim 16, Pepe et al. taught a forwarding facility for retrieving and forwarding the message to destinations provided to the subscriber in response to the alert (col. 20, lines 42-53).

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 8, 12 and 18 are rejected under 35 U.S.C. 103(a) as applied to claims 1, 2, 5-6, 9-10, and 13-16 as being unpatentable over Pepe et al. (5,742,905).

Pepe et al. did not expressly disclose the use of the automated telephone menu for responding to the alert. Pepe et al. did disclose the use of a telephone menu (col. 11, lines 14-32) and Pepe et al. discloses the use of cross media notification and performing the redirection in realtime (col. 20, line 42 - col. 21, line 53). Pepe et al. taught that the system is for operating with mobile equipment such as PDA, pager and cellular phone (col. 5, lines 56-67). It would have been obvious to one of ordinary skill in the art at the time of the invention in view of the cited teachings that an automated telephone menu for responding to the alert would have been an obvious modification, as Pepe et al. expressly disclosed that the media and format for delivery is selectable by the subscriber (col. 6, lines 1-19).

10. Claims 3, 7, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al. (5,742,905) as applied to claims 1, 2, 5-6, 9-10, and 13-16 above, and further in view of Fuller et al. (6,545,589).

Pepe et al. did not expressly disclose the involvement of an operator in the system, Fuller et al. taught the use of operator in a menu system to aid the user (col. 46, lines 12-30). It would

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have been obvious to one of ordinary skill in the data processing art at the time of the invention to allow for operator assists to aid the user in directing the calls.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mulligan et al.	5,937,161
Cohen et al.	4,837,798
Kane	5,487,100

12. A shortened statutory period for response to this action is set to expired THREE (3) months, ZERO days from the date of this letter. Failure to respond within the period for response will cause the application to be abandoned. 35 U.S.C 133.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. Donaghue whose telephone number is (703) 305-9675. The examiner can normally be reached on M-F from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax phone number for an official fax is (703) 746-7238, an after-final fax is 703-746-7238 and a draft or non-official fax is 703-746-7240.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LARRY D. DONAGHUE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Larry D. Donaghue", written in a cursive style.